



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,146	07/26/2001	Richard A.A. Heylen	204	8208

31665 7590 05/13/2005

PATENT DEPARTMENT
MACROVISION CORPORATION
2830 DE LA CRUZ BLVD.
SANTA CLARA, CA 95050

EXAMINER

SCHUBERT, KEVIN R

ART UNIT	PAPER NUMBER
----------	--------------

2137

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,146

Applicant(s)

HEYLEN, RICHARD A A

Examiner

Kevin Schubert

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7,9-12,14-16,18-20,22,23 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,9-12,14-16,18-20,22,23 and 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04122005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2137

DETAILED ACTION

Claims 1-3,5-7,9-12,14-16,18-20,22-23, and 25-29 have been considered.

Claim Rejections - 35 USC § 112

5 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10 Claims 1-7,9-12,14-16,18-20, and 28 are rejected under 35 U.S.C. 112, second paragraph.

As per claims 1-7,9-12,14-16,18-20, and 28, the term "rapid" is a relative term which renders the claims indefinite. The term "rapid" is not defined by the claim, the specification does not provide a
15 standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

As per claim 20, the term "generally" is a relative term which renders the claim indefinite. The term "generally" is not defined by the claim, the specification does not provide a standard for ascertaining
20 the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for
25 the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

30

Art Unit: 2137

Claims 1,3,5-7,9,11-12,14-16,18-20,23, and 25-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Hogan, U.S. Patent No. 5,699,434.

As per claims 1 and 11, the applicant describes a method describing the following limitation which
5 is met by Hogan:

Making up the authenticating signature from data patterns arranged such that the authenticating signature cannot be accurately written onto a copy disc by a writer for recordable discs which has a limited ability to look ahead during encoding, wherein the data patterns of the authenticating signature are arranged to have a DSV (digital sum value) which has a rapid rate of change, thereby to cause DSV
10 problems for writers of recordable discs (Col 3, lines 48-60; Col 5, line 64 to Col 6, line 25; Figs 3A,3B,3C,3D).

As per claim 3, the applicant describes the method of claim 1, which is met by Hogan, with the following limitation which is also met by Hogan:

15 Wherein successful operation of the copy protected disc requires that the disc be present in the drive and that a correct authenticating signature be readable therefrom (Fig 1; Col 4, lines 18-21).

As per claims 5,14, and 25, the applicant describes the method of claims 1,11, and 23, which are met by Hogan, with the following limitation which is also met by Hogan:

20 Wherein the data patterns ensure that the DSV has an absolute value significantly greater than usual (Col 3, lines 43-47).

As per claims 6,15, and 26, the applicant describes the method of claims 1,11, and 23, which are met by Hogan, with the following limitation which is also met by Hogan:

25 Wherein the data patterns which cause the DSV problems are repeated patterns of values (Fig 3A, Fig 3B, Col 3, lines 48-59).

Art Unit: 2137

As per claims 7, 16, and 27, the applicant describes the method of claims 1, 11, and 23, which are met by Hogan, with the following limitation which is also met by Hogan:

Wherein the size of the data patterns causing the DSV problems is a predetermined amount (Col 6, lines 42-49).

5

As per claims 9, 18, and 29, the applicant describes the method of claims 1, 11, and 23, which are met by Hogan, with the following limitation which is also met by Hogan:

Wherein the data patterns which cause the DSV problems are arranged to produce a DSV which has a substantial low frequency component lower than that of the lowest signal frequency that does not cause DSV problems (Col 3, lines 43-47; Fig 3B).

10

It is known in the art that the DSV is representative of a DC component. A high DSV, as is the case in Hogan, leads to a substantial low frequency component.

As per claim 12, the applicant describes the disc of claim 11, which is met by Hogan, with the following limitation which is also met by Hogan:

15

Wherein the data patterns of the authenticating signature have a size and/or nature which ensures that they cannot be accurately written by a writer of recordable discs (Col 3, lines 48-59; Col 1, lines 19-23).

20

As per claim 19, the applicant describes the disc of claim 11, which is met by Hogan, with the following limitation which is also met by Hogan:

Wherein the data patterns have been copied to a plurality of sectors on the optical disc.

25

As per claim 20, the applicant describes a method of authenticating a copy protected disc carrying encoded data, control data, and an authenticating signature, the encoded data, control data, and the authenticating signature having been applied to the disc during a mastering process wherein the authenticating signature is made up of data patterns arranged such that the authenticating signature

Art Unit: 2137

cannot generally be accurately written onto a copy disc by a writer of recordable discs which has a limited ability to look ahead during encoding, wherein the authenticating signature is of data patterns which cause DSV (digital sum value) problems and wherein the data patterns are arranged to have a DSV which has a rapid rate of change, thereby to cause DSV problems comprising the following limitation

5 which is met by Hogan:

Requiring a disc drive to locate and accurately read the authenticating signature on the disc in order to enable operation of the copy protected disc (Col 4, lines 11-23);

As per claim 23, the applicant describes a pre-mastering recordable disc for use in a process for

10 mastering optical discs comprising the following limitations which are met by Hogan:

a) user data to be carried on the optical discs (Col 4, lines 1-23);

b) a blocking file made up of data patterns added to the pre-mastering recordable disc during the authoring or premastering process, and wherein the data patterns cause DSV (digital sum value) problems for a disc drive, thereby the data patterns cannot be accurately read by a disc drive (Col 4, lines

15 1-23).

The errors in the pre-mastering disc comprises the blocking file. Though the errors comprising the blocking file may be able to be extracted by decoders and used for authentication purposes, they cannot be accurately read by a standard encoder and copies made by the pre-mastering disc will not include the errors comprising the blocking file.

As per claim 28, the applicant describes the pre-mastering disc of claim 23, which is met by Hogan, with the following limitation which is also met by Hogan:

Wherein the data patterns which cause the DSV problems are arranged to have a DSV which has a rapid rate of change (Col 5, line 64 to Col 6, line 25; Figs 3C and 3D).

Art Unit: 2137

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

5 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10 Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Newman, U.S. Patent No. 6,353,890.

As per claim 2, the applicant describes the method of claim 1, which is met by Hogan, with the following limitation which is met by Newman:

15 Wherein the existence of corrupted or otherwise incorrect data in a particular sector on the optical disc signifies that that disc is not original whereby its use may be prevented (Newman: Col 10, lines 14-21);

Hogan describes all the limitations of claim 1. However, Hogan fails to identify the use of corrupt or incorrect data on a particular sector to signify that the disc is not original. The errors in Hogan's system
20 only serve to create a large DSV which inhibits copying of the disc. The errors in Newman's system serve to signify that the disc is or is not original. If the disc is not original, its use is not permitted.

It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Newman with those of Hogan and allow for the data patterns to authenticate whether use of a disc is or is not permitted because doing this installs an additional security feature in the
25 system.

As per claim 10, the applicant describes the method of claim 1, which is met by Hogan, with the following limitation which is met by Newman:

Art Unit: 2137

Wherein the authenticating signature is also made up of sectors containing only zeros which are provided both before and after sectors containing the chosen data patterns (Newman: Col 3, lines 15-20; Col 3, lines 60-65);

5 Hogan describes all the limitations of claim 1. However, Hogan fails to describe the use of padding sectors with zeros before and after sectors containing chosen data patterns.

As described by the applicant in the specification, sectors in the disc can be padded in order to facilitate reading or normal play of the optical disc. According to Newman, unused sectors of the disc can be padded in order to facilitate the operation of the optical disc in that it is easier for standard reading devices to process information in this error and non-error sector format (Col 3, lines 20-25).

10 Though Newman does not discuss the specific use of only zeros, he does say that these areas are error free and a simple error free sector is one containing only zeros. Furthermore, the use of having sectors containing zeros next to sectors containing data patterns is disclosed by Newman: "at least one non-error location is selected which adjoins an error location" (Col 3, lines 60-65). Newman has the sector non-error sector adjoin the sector of error patterns for ease in processing of the access control
15 information.

It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Newman with those of Hogan and add sectors containing only zeros before and after the sectors containing data patterns because it is easier for standard reading devices to process information in this format.

20

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Tanaka, U.S. Patent Application No. 2001/0011237.

25 As per claim 22, the applicant describes a method of enabling the mastering of an optical disc by an enabled encoder, where a pre-mastering recordable disc carries user data which is to be read by, a drive associated with the enabled encoder during the mastering process, and carries a blocking file made up of data patterns which cannot be accurately read by a disc drive wherein the data patterns cause the

Art Unit: 2137

DSV (digital sum value) problems for a disc drive, the method comprising the following limitation which is met by Hogan in view of Tanaka:

Providing on the pre-mastering recordable disc information as to the existence and location of the blocking file, the drive associated with the enabled encoder being arranged not to read the blocking file in response to the existence and location information (Tanaka: [0091]-[0096], Fig 8);

Hogan describes all the limitations of the preamble. Hogan also describes a pre-mastering recordable disc and a blocking file of errors. Hogan also discloses that information as to the existence and location of the blocking file, or errors, is provided by the pre-mastering disc to a decoder which extracts the errors and uses them for authentication purposes. Hogan does not disclose that an encoder is arranged not to read the blocking file in response to the existence and location information.

Tanaka discloses a system for mastering a disc in which a pre-mastering disc provides copyright information to an encoder seeking to master a disc. If the pre-mastering disc is set so that copyright is disabled, the usable data (such as music data) is set as a blocking file. The copyright information provides information as to the existence and location of the blocking file because it alerts the encoder that the usable data (such as the music data) exists as a blocking file and cannot be copied.

Combining Tanaka into the system of Hogan would simply mean that copyright information is added that specifies to the encoder that the errors of Hogan's system cannot be copied because they provide an authentication signature for the system. This benefits the system because the system does malfunction from DSV errors trying to read and record the blocking file. Thus, the disc remains safeguarded and the system does not experience DSV errors. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Tanaka with those of Hogan because doing so allows the disc contents to be protected from piracy as taught by Hogan while curing the deficiency of Hogan's system of the DSV complications and malfunctions to the encoder trying to read the blocking file.

Response to Arguments

Art Unit: 2137

Applicant's arguments, see Remarks, filed 4/12/05, with respect to the 112 rejections of claims 5,9,14,18,22,23, and 25 have been fully considered and are persuasive. The rejections have been withdrawn.

5 Applicant's arguments with respect to the 112 rejection of claims 8,17, and 28 have been fully considered and are not persuasive. The applicant should note that the rejections now apply to amended claims 1-7,9-12,14-16,18-20, and 28. The applicant contends that a "rapid" rate of change means that the rate of change of the DSV is higher than the frequency associated with a 3T pit. This is not disclosed by the specification nor is this consistent with the specification. The specification teaches that DSV is
10 determined by assigning the value +1 to each land, and -1 to each pit (page 11). Whereas normal encoding schemes try to keep the absolute value of DSV as close to 0 as possible, the applicant's system tries to keep the DSV as high an absolute number as possible. The applicant also stresses that it is the rate of change of the DSV to a high absolute number rather than the number itself of the DSV which is most critical in the applicant's system (page 4). Thus, a "rapid rate of change" in the DSV as taught by
15 the specification implies a high rate of change of the absolute number associated with the DSV. While the examiner has considered the applicant's response that "rapid" signifies having a frequency greater than the frequency associated with a 3T pit, the examiner does not see the support for this in the specification and does not see how this definition is consistent with the teachings of the specification.

20 Applicant's arguments with respect to claims 1 and 11 have been fully considered but they are not persuasive. The applicant contends that the claims are patentable based on the two additions to the claims.

The first addition to the claim is the addition of the writer having "a limited ability to look ahead during encoding". Hogan discloses that a special encoder has the ability to look far ahead and make the
25 best decisions for the encoder as far as DSV is concerned. A standard encoder has a limited ability to look ahead and thus makes decisions based on the short term instead of the long term which leads to DSV problems (Col 5, line 64 to Col 6, line 25). Furthermore, Hogan illustrates this in Figs 3A,3B,3C, and

Art Unit: 2137

3D. Figs 3A and 3B relate to a standard encoder which has a limited ability to look ahead during encoding. Figs 3C and 3D relate to a special encoder which can look far ahead during encoding.

Though the standard encoder may make short term decisions which seem optimal, its inability to see far ahead precludes it from making the best decision in the long run as can be seen in Fig 3B where the DSV of the standard encoder is accumulating in a negative direction indefinitely. The examiner disagrees with the applicant that Hogan does not disclose the encoder having a limited ability to look ahead.

The second addition to the claim is the addition of the data patterns arranged to have a DSV having a rapid rate of change. As illustrated by Figure 3B, Hogan shows that the DSV has a rate of change as the DSV extends in the negative direction indefinitely (Col 6, lines 23-24). Calling this rate of change "rapid" is a matter of interpretation.

Applicant's arguments with respect to claims 20,22, and 23 have been considered but are moot in view of the new ground(s) of rejection. As per claim 22, the examiner reviewed the claim based on the preamble having patentable weight and rejected the claim under 35 U.S.C. 103(a) with combined reference Hogan to meet the preamble instead of 35 U.S.C. 102(b). The examiner requests clarification as to whether the applicant wishes the preamble of claims 20,22, and 23 to have patentable weight in the claim.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2137

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER